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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,360	01/25/2001	Yoshinobu Nakamura	122.1431	3644
21171	7590	06/29/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			LEE, CHRISTOPHER E	
			ART UNIT	PAPER NUMBER
			2112	

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/768,360	<b>Applicant(s)</b> NAKAMURA, YOSHINOBU	
	<b>Examiner</b> Christopher E. Lee	<b>Art Unit</b> 2112	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Receipt Acknowledgement***

1. Receipt is acknowledged of the request filed on 17<sup>th</sup> of May 2004 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on the Application No. 09/768,360, which the request is acceptable and an RCE has been established. Claims 1-7 have been amended; no claim has been canceled; and no claim has been newly added since the Final Office Action was mailed on 19<sup>th</sup> of February 2004. Currently, claims 1-8 are pending in this application.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In the claims 1, 4 and 7, the Applicant recites the limitation "the peripheral unit manager stores property information and address information corresponding to each peripheral unit to access the peripheral unit on the network" in lines 3-5 of the claims 1 and 4, and in lines 4-6 of the claim 7, respectively. However, the original specification was not describe that the peripheral unit manager accesses the peripheral unit on the network using the stored property information and address information corresponding to the peripheral unit. The claims 2, 3 and 8 are dependent claims of the claim 1, and the claims 5 and 6 are dependent claims of the claim 4.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims 1, 4 and 7 recite the limitation "the data" in line 19 of the claim 1, in lines 18-19 of the claim 4, and in lines 21-22 of the claim 7, respectively. There is insufficient antecedent basis for this limitation in the claim, respectively. Therefore, the term "the data" could be considered as --the peripheral information and the address information-- since it is not clearly defined in the claims. The claims 2, 3 and 8 are dependent claims of the claim 1, and the claims 5 and 6 are dependent claims of the claim 4.

The claim 8 recites the limitation "the serial number" in line 2. There is insufficient antecedent basis for this limitation in the claim. Therefore, the term "the serial number" could be considered as --a serial number-- since it is not clearly defined in the claims.

#### ***Claim Rejections - 35 USC § 102***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Berglund et al. [US 6,427,176 B1; hereinafter Berglund].

*Referring to claim 1*, Berglund discloses a peripheral unit management system (i.e., an apparatus for maintaining system labeling; See col. 1, lines 21-23) to manage a plurality of peripheral units (i.e., maintaining system labeling for subsystems A-F and C'-E' in Fig. 1) using a peripheral unit manager (i.e., OS 101, Service Processor 103, and SPCN 107 in Fig. 1) via a network (i.e., I2C bus in Fig. 1; See col. 10, lines 17-26), wherein said peripheral unit manager (i.e., OS, SP and SPCN) stores property information (e.g., PART # within table 3 in Fig. 2A) and address information (e.g., HARDWIRED ADDR. within table 3 in Fig. 2A) corresponding to each peripheral unit (See col. 5, lines 22-25; in fact, SPCN (i.e., peripheral unit manager) establishes (i.e., stores) a reference table (i.e., property information and address information) corresponding to each subsystem (i.e. peripheral unit)) to access said peripheral

unit on said network (See col. 6, lines 28-35), comprising: a reading unit (i.e., means for retrieving by SPCN 107 in Fig. 1) reading (i.e., retrieving) said property information and said address information from each of said peripheral units (See col. 6, lines 5-13); a determining unit (i.e., means for querying by SPCN 107 in Fig. 1) determining (i.e., querying) that one of said peripheral units has been replaced when said property information read does not coincide with said property information (i.e., PART #) stored in said peripheral unit manager (i.e., a different part number from the part number in the reference table is detected at the known hardwired address; See col. 10, line 65 through col. 11, line 6), and when detecting that said address information (i.e., HARDWIRED ADDR.) of one of said peripheral units is new (i.e., new subsystem is plugged at the known hardwired address; See col. 10, lines 40-46), and an obtaining unit (i.e., means for hot-plugging with SPCN 107 in Fig. 1; See col. 8, lines 13-22) obtaining said new address information (i.e., hardwired address, hardware resource information,) of said peripheral unit (See col. 10, lines 40-46), and, when said property information read does not coincide with said property information (i.e., PART #) stored in said peripheral unit manager (i.e., a different part number from the part number in the reference table is detected at the known hardwired address), storing said property information read and said new address information of said one of said peripheral units (See col. 11, lines 15-25; i.e., wherein in fact that the new part number or numbers are written into table A in place of the old part number or numbers of the device or devices replaced inherently anticipates the step of storing said property information read and said new address information of said one of said peripheral units).

*Referring to claim 2*, Berglund teaches each peripheral unit (i.e., subsystem in Fig. 1) comprises a main body (e.g., backplane; See col. 6, line 9) having a first recording medium (i.e., VPD chip in said subsystem in Fig. 1; See col. 8, lines 43-44) to record said property information (i.e., PART #; See col. 8, lines 45-47), and a board (e.g., card device) having a second recording medium (i.e., memory disposed on said card device; See col. 7, lines 56-58) to record said address information (i.e., HARDWIRED ADDR), wherein said board (i.e., card device) is inserted to and removed from said main body (See col. 7, lines

58-59) and performs a connecting function to said network (i.e., I2C network in Fig. 1) to enable each peripheral unit to transmit said property information and said address information (See col. 7, lines 59-61) and determines whether or not said main body (i.e., backplane) of said peripheral unit (i.e., subsystem) has been replaced (See col. 10, lines 40-46; i.e., wherein in fact that SPCN recognized when subsystems C and D have been removed and new subsystem C' has been plugged (i.e., card devices and backplane within said subsystem C has been replaced by new subsystem C'), and can report this immediately to the operating system clearly anticipates said management system (i.e., OS) determines whether or not said main body (i.e., backplane) of said peripheral unit (i.e., subsystem) has been replaced).

*Referring to claim 3*, Berglund teaches each peripheral unit (i.e., subsystem in Fig. 1) comprises a main body (i.e., chassis FRU) and a board (i.e., chassis FRU component; e.g., card device on backplane) having a first recording medium (i.e., VPD memory) to record said property information (i.e., part number; See col. 8, lines 45-56) and a second recording medium (i.e., memory disposed on card device; See col. 7, lines 56-58) to record said address information (i.e., unique location information - HARDWIRED ADDR.), wherein said board (e.g., card device) is inserted to and removed from said main body (See col. 7, lines 58-59; i.e., said card device on backplane could be can be inserted to and removed from said body) and performs a connecting function to said network (i.e., I2C network in Fig. 1) to enable each peripheral unit to transmit said property information and said address information over said network (See col. 7, lines 59-61), and when said board (i.e., said card device) is replaced (See col. 12, lines 12-15), said management system (i.e., operating system) reads said address information recorded in said second recording medium (i.e., querying reference table; See col. 10, line 65 through col. 11, line 6), and determines whether or not said main body (i.e., chassis FRU) of said peripheral unit (i.e., subsystem) has been replaced (See col. 10, lines 40-46; i.e., wherein in fact that SPCN recognized when subsystems C and D have been removed and new subsystem C' has been plugged (i.e., card devices and backplane within said subsystem C has been replaced by new subsystem C'), and can report this immediately to the

operating system clearly shows said management system (i.e., OS) reads said serial number and said ID number and determines whether or not said main body (i.e., backplane) of said peripheral unit (i.e., subsystem) has been replaced).

*Referring to claim 4*, the method steps of claim 4 are inherently performed by the apparatus of claim 1, and therefore the rejection of claim 1 applies to claim 4.

*Referring to claim 5*, the method steps of claim 5 are inherently performed by the apparatus of claim 2, and therefore the rejection of claim 2 applies to claim 5.

*Referring to claim 6*, the method steps of claim 6 are inherently performed by the apparatus of claim 3, and therefore the rejection of claim 3 applies to claim 6.

*Referring to claim 7*, most of the claim limitations have already been discussed/addressed with respect to claim 4, with the exception of recording medium readable by a computer and used for said peripheral unit management method, and said medium having a program recorded thereon to make the computer execute said method steps.

However, the recitation in the claim 7, that "recording medium readable by a computer and used for said peripheral unit management method, and said medium having a program recorded thereon to make the computer execute said method steps" has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *See Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

*Referring to claim 8*, Berglund teaches said property information (i.e., PART # within table 3 in Fig. 2A) comprising a serial number (i.e., part number) of said corresponding peripheral unit (See the definition of the serial number in the specification page 9, lines 5-9; in fact, said serial number is anticipated by the part number of the Berglund).



***Response to Arguments***

8. Applicant's Response/Amendment filed on 17<sup>th</sup> of May 2004 does not have any arguments.

***Conclusion***

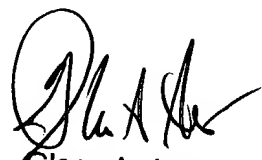
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher E. Lee whose telephone number is 703-305-5950. The examiner can normally be reached on 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark H. Rinehart can be reached on 703-305-4815. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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